



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of)
SPAMPINATO, et al.) Art Unit: 2855
Serial Number 10/797,600) Examiner: Bonanto, G.
Filed: March 11, 2004) Attorney Reference: 005127.00270
For: TESTING APPARATUS)

REPLY BRIEF

Commissioner for Patents
U.S. Patent and Trademark Office
Alexandria, VA 22313

Sir:

In reply to the Examiner's Answer, mailed June 5, 2006, Appellants respectfully submit this Reply Brief in the above-captioned appeal to the Board of Patent Appeals and Interferences.

i. Summary of Claimed Subject Matter

The Examiner's Answer indicates that the Summary of Claimed Subject Matter contained in the Appeal Brief filed April 28, 2006 is deficient. More particularly, the Examiner's Answer states that the Summary of Claimed Subject Matter is deficient because it fails to explain that (a) "the overall shape of housing 20 limits fluid forces...upon housing 20" and (b) the "overall shape of housing 20 minimizes disturbances of the air flowing within the wind tunnel...." As stated in 37 CFR 41.37(c)(1)(v), the Appeal Brief should contain "A concise explanation of the subject matter defined in each of the independent claims involved in the appeal...." While the Examiner has noted advantages of the invention, neither of these advantages are actually defined or otherwise recited in the claims (although the claims cover testing apparatuses having these advantages). The Applicants respectfully submit, therefore, that the Summary of Claimed Subject Matter contained in the Appeal Brief filed April 28, 2006 compiles with requirements for the Appeal Brief.

ii. Response to Examiner's Comments on Limitations

Independent claim 10 stands rejected over Demay, Holderer, and Mehta. To establish obviousness, the burden is upon the Examiner to demonstrate that the prior art references teach or suggest all claim limitations. That is, all of the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (C.C.P.A. 1974). None of the prior art references cited by the Examiner against independent claim 10, however, disclose a rounded leading edge and a tapered trailing edge. In response to similar arguments in the Appeal Brief, the Examiner's Answer states that "the rejection did not rely on Demay et al. disclosing a rounded leading edge and a tapered trailing edge" (Examiner's Answer, page 5). Moreover, the Applicants submit that the rejection did not actually suggest that any of Demay, Holderer, and Mehta disclose a rounded leading edge and a tapered trailing edge. Furthermore, a review of Demay, Holderer, and Mehta by the Applicants does not reveal the disclosure of a rounded leading edge and a tapered trailing edge. All of the claim limitations must, however, be taught or suggested by the prior art. Accordingly, the Applicants respectfully submit that the rejection should be withdrawn.

iii. Response to Examiner's Comments on Motivation

In rejecting various claims, the Examiner stated that it would have been obvious to "modify the streamlined casing of Demay et al. by making it tear-drop shape as taught by Meyer in order to make the support strong and light" (Office Action, page 9, final 3 lines). In the Appeal Brief, the Applicants argued that there is no showing or even an attempt to demonstrate that a combination of Demay, Holderer, and Meyer would actually provide a stronger or lighter support. That is, the rejection merely asserts that the combination would increase strength and decrease weight without any attempt to actually demonstrate that strength would be increased or weight would be decreased. According to the Examiner's Answer, however, no such proof or disclosure is required for a proper combination of references.

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. *In re Geiger*, 815 F.2d 686, 688, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987). The Examiner has supplied a purported motivation, but there is no evidence to support the Examiner's conclusion that strength would be increased or weight would be decreased. Rather, the Examiner has merely provided a conclusion to support his position, without any evidence

supporting the conclusion. While the Examiner argues that no such proof or disclosure is required for a proper combination of references, the Applicants respectfully submit that at least enough proof or disclosure should exist to verify the accuracy of the Examiner's conclusions. That is, the Examiner should not be permitted to draw a factual conclusion and rely upon that conclusion without having a factual basis for making the conclusion.

iv. Response to Examiner's Comments on Intended Purpose

As noted above, the Examiner proposed to "modify the streamlined casing of Demay et al. by making it tear-drop shape as taught by Meyer in order to make the support strong and light" (Office Action, page 9, final 3 lines). Demay is concerned with a support device for a motorized flying instrument. More particularly, the "invention applies to wind tunnel tests carried out on any type of motorized flying instrument and particularly a prototype or a scale one model, fitted with a motor, of a *missile* of which it is desired to study the behavior in real time in a *supersonic tunnel*, hands off, by reconstructing the changes in dynamics representative of the flight attitudes of the instrument" (Demay, column 1, lines 14-20, emphasis added). That is, an example of the subject matter encompassed by Demay is supersonic wind tunnel tests of a missile. In contrast, Meyer is concerned with a mast for watercraft having a sail.

The Applicants will refrain from estimating the relative velocities of a missile and watercraft with a sail, but note that differences on an order of magnitude may be reasonable. The rejection takes an element from Meyer (i.e., sail from a watercraft) and combines the element from Meyer with the support of Demay (i.e., a support for supersonic wind tunnel testing of a missile). Despite these differences in relative wind velocities, the Examiner contends that the element from Meyer is suited for use with the support of Demay, but there is no evidence to support the Examiner's conclusion that the strength or aerodynamic properties of the element from Meyer would be sufficient to withstand the wind velocities associated with a support for supersonic wind tunnel testing of a missile.

Conclusion

The Applicants respectfully submit that rejections submitted in the final Office Action mailed December 28, 2005 and the Advisory Action mailed March 29, 2006 should be reversed

for at least the reasons recited above and also for the reasons recited in the Appeal Brief. Allowance of claims 10-12, 14-17, and 34-38 is, therefore, respectfully requested.

Applicants submit this Reply Brief to the Board of Patent Appeals and Interferences in accordance with 37 C.F.R. §41.41. It is believed that no fees are due in connection with this Reply Brief. Should fees be deemed necessary, however, such fees are hereby requested and the Commissioner is authorized to charge deposit account number 19-0733 for the payment of the requisite fee.

Respectfully submitted,

By: 
Byron S. Kuzara
Registration No. 51,255

Banner & Witcoff, Ltd.
1001 G Street, N.W.
Washington, D.C. 20001-4597
Telephone: (503) 425-6800

Dated: June 21, 2006